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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding             | 91200355  |
| Party                  | Plaintiff<br>Motorola Mobility, Inc., Motorola Trademark Holdings, LLC  |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|--|---|---------------------------|
| Application Serial No. 78/575,442                    | ) |                           |
| Filed: February 25, 2005                             | ) |                           |
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| <i>Gazette</i>                                       | ) |                           |
| For: SOUND MARK                                      | ) |                           |
|  | ) |                           |
| Motorola Mobility, Inc. and Motorola                 | ) |                           |
| Trademark Holdings, LLC,                             | ) |                           |
|  | ) |                           |
| Opposers,  | ) |                           |
| vs.  | ) |                           |
|  | ) |                           |
| Nextel Communications, Inc.                          | ) |                           |
|  | ) |                           |
| Applicant.   | ) |                           |

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**OPPOSERS' RESPONSE TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT  
ON PRECLUSION**

Pursuant to Fed. R. Civ. P. 56 and Trademark Rule 2.127(e)(1), Opposers Motorola Mobility, Inc. and Motorola Trademark Holdings, LLC (collectively, "Motorola") hereby respond to Applicant Nextel Communications, Inc.'s ("Applicant" or "Nextel") motion for summary judgment on preclusion.<sup>1</sup>

**I. INTRODUCTION**

Motorola and Nextel have cross-moved for summary judgment on the claim preclusion and issue preclusion grounds pleaded in Motorola's Notice of Opposition. Motorola's position,

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<sup>1</sup> Per the Board's Order dated December 8, 2011 (Dkt. #8), Motorola has filed a cross-motion for summary judgment on preclusion grounds (Dkt. #12).

as set forth in its co-pending summary judgment motion (Dkt. #12), is that the Board’s prior precedential decision sustaining Nextel’s opposition to Motorola’s “Chirp Tone” trademark application on invalidity grounds precludes Nextel’s application to register the identical Chirp Tone as a service mark. See *Nextel v. Motorola*, Opposition No. 91/164,353 (“*Nextel v. Motorola*”), published as *Nextel Communications, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393 (T.T.A.B. 2009) (precedential). In contrast, Nextel’s position is that the prior *Nextel v. Motorola* Chirp Tone holding is largely irrelevant to its Chirp Tone application—notwithstanding the undisputed inter-relatedness and overlap between the parties’ goods and services. Nextel argues that it is entitled to a clean slate with respect to validity of the Chirp Tone, despite the Board’s holding—procured by Nextel as the opposer—that the Chirp Tone failed to function as a mark, was not inherently distinctive, and had not acquired distinctiveness in connection with Motorola’s communications goods that interoperate with the Nextel service.

Although Nextel argues that claim and issue preclusion do not apply as a matter of law, Nextel’s summary judgment motion includes a critical admission that seals the fate of its Chirp Tone application: Nextel admits that certain services within its Class 38 application, including its “two-way radio services,” utilize the Chirp Tone as an operational alert tone in the normal course of the services (Dkt. #11, Nextel SJ Motion at 3-4, 8, ¶¶ 2-3, 5, 19.):

***19. Nextel’s Application encompasses services as to which the sound is emitted in the normal course of providing them (such as “push to talk” walkie-talkie communications services that operate on the iDEN network) as well as services as to which the Nextel Chirp is not emitted at all (such as position tracking data transmission services)....***

*Id.* at 8, ¶ 19. That admission eviscerates any distinction Nextel seeks to draw between “communications goods” versus “communications services” for validity and preclusion

purposes, and brings Nextel's application squarely within the parameters of the *Nextel v. Motorola* holding.

Nextel's admission that the Chirp Tone is an operational alert tone in connection with several of its applied-for services bars Nextel's application. The Board held in the prior precedential *Nextel v. Motorola* decision that the Chirp Tone cannot function as a mark for goods using the Chirp Tone as an operational alert tone. That holding is equally applicable to Nextel's interdependent services that similarly use the Chirp Tone as an operational alert tone. (See Section III. A. below.) Because the Chirp Tone fails to function as a mark in connection with those applied-for services, registration must be denied as to the Class 38 services as a whole. (See Section III. B. below.) To the extent Nextel's Chirp Tone application survives the *Nextel v. Motorola* alert tone preclusion bar, Nextel's operational alert tone admission also confirms that the *In re Vertex* rule applies, barring inherent distinctiveness for sounds emitted in the normal course of operation. (See Section III. C. below.) As a result, Nextel would be required to prove acquired distinctiveness. It cannot do so in light of concurrent use of the Chirp Tone by Motorola (and a third party), which the Board held to be "most damaging" to acquired distinctiveness in the prior precedential *Nextel v. Motorola* decision. (See Section III. D. below.) The claims and issues before the Board in the present case have already been fully litigated and adjudicated in the prior *Nextel v. Motorola* opposition.

Nextel chose to oppose the Chirp Tone on invalidity grounds in *Nextel v. Motorola*. It must now abide by the ruling it obtained. As explained herein, and in Motorola's cross-motion, that holding precludes Nextel's application. Given the lack of genuine issues of material fact, summary judgment in Motorola's favor—not Nextel's—is appropriate.

## **II. FACTUAL BACKGROUND**

### **A. The Parties' Interrelated Goods and Services**

There is no dispute that Motorola manufactures cellular telephone handsets sold to Nextel and others that incorporate a walkie-talkie (or two-way radio) function. (Dkt. #10, Nextel Am. Answer at ¶¶ 4-5.) Further, there is no dispute that these handsets emit the Chirp Tone in the course of operation. (Id.) Most significantly, Nextel admits that its applied-for two-way radio services, and other services, utilize the Chirp Tone as an operational alert tone in the normal course of the services. (Id.)

### **B. Nextel's Statement of Facts**

Nextel's summary judgment motion included a numbered list of uncontested facts (repeated in italics below). Motorola's response follows.

*1. Applicant provides wireless communications services. One of the services it offers is "Direct Connect" two-way radio service provided to its subscriber customers over its network, in part using equipment manufactured by Opposer, see Opp. at ¶ 5, and by other manufacturers.*

#### **Motorola's Response to Para. 1:**

Admitted.

*2. In connection with the operation of the Direct Connect service, the subscribers' wireless devices emit a variety of operational alert tones to signal the user of various status conditions and events. One such tone, which Applicant refers to as the "Nextel Chirp," and which is emitted to signal the "talk permit" status of certain two-way radio communications, is the subject of this proceeding. See id. at ¶¶ 4, 7.*

#### **Motorola's Response to Para. 2:**

Admitted.

*3. Applicant seeks registration of the Nextel Chirp based on its use of that sound as a source-identifying brand for a range of services it offers, including not only services for which the sound is an operational alert tone but also services in which the Nextel Chirp is not heard at all (i.e., what Opposer calls "non-iDEN" services, see id. at ¶33), and as a brand identifier for Nextel services in general. See id. at ¶ 7.*

**Motorola's Response to Para. 3:**

Motorola admits that Nextel seeks registration of the Chirp Tone for services that utilize the tone as an operational alert tone, as well as other services identified in the application at issue (Ser. No. 78/575,442). Nextel's Chirp Tone service mark application expressly covers a limited list of related communications services. Motorola denies that application Ser. No. 78/575,442 covers a brand identifier for Nextel services in general or a full line of communications services as defined by T.M.E.P. 1402.03(c). (See Ser. No. 78/575,442.)

4. *The Nextel Chirp has been used by Nextel as a brand in connection with advertising "iDEN-based" and "non-iDEN" service offerings since at least 1997. See id. at ¶ 15.*

**Motorola's Response to Para. 4:**

Motorola denies that Nextel has used the Chirp Tone "as a brand" in connection with iDEN®-based and non-iDEN® services since 1997. Nextel has cited no evidence supporting this allegation. Its only record citation is to Motorola's Notice of Opposition at Para. 15, which merely quotes a Declaration executed by a Nextel witness and submitted to the U.S.P.T.O. To that end, Motorola has pleaded fraud on the U.S.P.T.O. as a separate ground for opposition based Nextel's statements to the Examining Attorney. (See Dkt. #1, Not. Of Opp. at 33-35.) Motorola's quotation of Nextel's declarants' statements to the U.S.P.T.O. does not constitute an admission of the truth of those quoted statements. Nextel has not met its burden of establishing these purported first use dates. Consequently, the evidentiary burden has not shifted to Motorola to show a genuine factual issue relating to first use dates. T.B.M.P. § 528.01. Moreover, first use dates are not relevant to the claim and issue preclusion grounds at issue in the motion.

5. *During the application process, Nextel stated in a response to an Office Action that "the following services listed in the application involve emission of the sound mark identified in the instant application in the provision of such services:*

*Electronic, electric and digital transmission of voice, data, pictures, music, video, and other electronic information via wireless networks; Two-way radio services; Electronic transmission of voice, text, images, data, music and information by means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; Mobile telephone communication services; Wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, information, text, numeric messaging and text messaging and for accessing a global communications network; Telecommunication services, namely, providing user access to telephone and Internet wired or wireless networks for the transmission of voice, data, images, music or video via a combination of persistent interconnection and instant interconnection/instant interrupt technologies; and Wireless communications services." See id. at ¶ 12.*

**Motorola's Response to Para. 5:**

Motorola admits that Nextel made the quoted statements to the U.S.P.T.O. in connection with its Chirp Tone application (Ser. No. 78/575,442), namely, that those services—including “two-way radio services” and others—“involve emission of the [Chirp Tone] identified in the instant application in the provision of such services.”

6. *With respect to those services, Nextel stated that "applicant believes that the mark has acquired distinctiveness with respect to the foregoing services, submits a declaration regarding the same, and seeks registration of those services pursuant to Section 2(f) of the Trademark Act." Id.*

**Motorola's Response to Para. 6:**

Motorola admits that Nextel made the quoted statements to the U.S.P.T.O. in connection with its Chirp Tone application (Ser. No. 78/575,442), namely, that it sought registration as to those services—including “two-way radio services” and others—on acquired distinctiveness grounds.

7. *During prosecution, Nextel did not submit a claim that the Chirp Tone has acquired distinctiveness in connection with the remaining services listed in its application,*

*namely "Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Wireless internet access services." Id. at ¶ 13.*

**Motorola's Response to Para. 7:**

Motorola admits that Nextel did not initially submit a claim of acquired distinctiveness to the U.S.P.T.O. in connection with certain services identified in its Chirp Tone application (Ser. No. 78/575,442). However, Nextel has now claimed, at least in the alternative, acquired distinctiveness as to all services in the application. (Dkt. #10, Nextel Amended Answer at Aff. Def. 1.)

8. *Applicant and Opposer have already litigated a substantial opposition proceeding involving this same sound, see id. at ¶¶ 8-9, which resulted in the Board decision in Nextel v. Motorola [n]. That proceeding involved Motorola's attempt to register the sound as a mark for the wireless devices it manufactured and sold to Nextel. See id., 91 U.S.P.Q.2d at 1395. Motorola argued that it had used the sound as a trademark because the sound was "affixed" to its goods upon sale, and because it was audible as part of Motorola's demonstration of the operation of its goods at trade shows and as part of depictions of their operation in product placements and in Motorola's advertising. See id. at 1404-1406. The Board held, however, that with respect to the applied-for goods, the chirp sound was an operational alert tone that could not be considered inherently distinctive, and Motorola's "use" of the tone in merely demonstrating or depicting the operation of the product did not result in acquired distinctiveness of the chirp sound as a trademark for Motorola's products. Id. at 1401, 1403-1405.*

**Motorola's Response to Para. 8:**

Admitted, in part. Regarding evidence, Motorola presented additional advertising evidence to the Board, including but not limited to co-operative advertising by the parties. *Nextel*, 91 U.S.P.Q.2d at 1398 (discussing co-op advertising evidence). Regarding the Board's holding, the Board noted that the "most damaging" evidence defeating Motorola's acquired distinctiveness claim was the parties' concurrent use of the Chirp Tone. *Nextel*, 91 U.S.P.Q.2d at 1408.

9. *Nextel, as Opposer in the prior proceeding, presented evidence showing that, by contrast to Motorola, it had used the sound as a mark, in extensive national radio and television advertising over many years, reinforcing the sound mark even in print advertising, for example, by touting Nextel services as "pretty chirping fast." Id. at 1398. Motorola argued that any*



*trademark significance of the chirp sound garnered through Nextel's extensive advertising should accrue to its own benefit because of its purported partial funding of those advertisements through a co-op credit program. Id. at 1406-1407.*

**Motorola's Response to Para. 9:**

Motorola admits that Nextel presented the identified evidence in the prior *Nextel v. Motorola* opposition. Motorola admits that it presented evidence establishing that Nextel used Motorola's co-operative advertising funding in promoting its two-way radio communications services.

10. *The Board found, however, that Nextel's advertisements were "noticeably different from [Motorola's] advertisements and product placements ... , inasmuch as the chirp is played in a manner not necessarily associated with the normal operation" of the devices, but "is either emitted gratuitously or as an audible prompt used to underscore points made by the narrator" regarding features of the cellular telephone or associated services. Id. at 1407. The Board also found that "in all of [Nextel's] advertisements of record, the source-association made with the chirp, if any, is with 'Nextel.' "* *Id.* *The Board found that the television commercials thus did not show "use of the chirp as a source-identifier for [Motorola's] goods," and did not support Motorola's acquired distinctiveness assertion. Id.*

**Motorola's Response to Para. 10:**

Motorola admits that the quoted passages appear in the *Nextel v. Motorola* decision.

11. *Based on its review of the advertising evidence, the Board further observed that the impression the spots created was that the advertiser was seeking "to associate the chirp with 'Nextel,'" and that notwithstanding Nextel's sale of both goods and services, "to the extent that a viewer of these advertisements would consider the chirp as a trademark, it is more likely that the viewer would associate the chirp with [Nextel's] services, rather than [Motorola's] cellular telephones." Id. at 1408. The Board concluded that because of the nature of the advertising, "we cannot find that consumers would associate the chirp with [Motorola's] cellular telephones." Id.*

**Motorola's Response to Para. 11:**

Motorola admits that the quoted passages appear in the *Nextel v. Motorola* decision.

12. *Nextel also presented a pair of consumer surveys, credited by the Board, that showed that a substantial majority of respondents associated the chirp sound with a single source of goods or services, and that 53 percent of all respondents associated that sound with Nextel, compared with 1.5 percent for Motorola. Id. at 1402-1403. The Board concluded, that "[i]n sum, the Jacoby testimony and surveys do not support [Motorola's] claim that the chirp has acquired distinctiveness for [Motorola's] cellular telephones." Id. at 1403.*

**Motorola's Response to Para. 12:**

Motorola admits that the quoted passages appear in the *Nextel v. Motorola* decision.

13. *Based on all the evidence before it, the Board held that the chirp "has not acquired distinctiveness for [Motorola's] cellular telephones." Id. at 1408.*

**Motorola's Response to Para. 13:**

Admitted.

14. *The Board was clear that it was not deciding whether the chirp had acquired distinctiveness as a Nextel mark. In fact, the Board expressly stated that "... we make no finding herein that the chirp has acquired distinctiveness in connection with [Nextel's] services (that issue is not before us) ...". Id. at 1403. The Board reiterated this point, stating "Again, we make no finding as to whether the chirp serves as a trademark for opposer's services as that issue is not currently before us. Rather, based on the use of the 'Nextel' name in the advertisements, we cannot find that consumers would associate the chirp with [Motorola's] cellular telephones." Id. at 1408 [n].*

**Motorola's Response to Para. 14:**

Motorola admits that the *Nextel v. Motorola* decision covered Motorola's Chirp Tone trademark application and that Nextel's Chirp Tone service mark application was not before the Board. Nextel's Chirp Tone service mark application (Ser. No. 78/575,442) was suspended by the U.S.P.T.O. pending the outcome of Motorola's prior-filed Chirp Tone trademark application. (See 78/575,442 Notice of Suspension dated February 28, 2007.) Motorola admits that the quoted passages appear in the *Nextel v. Motorola* decision.

15. *The Board specifically acknowledged that Nextel's application had been suspended pending the outcome of its opposition to Motorola's application. Id. at 1397-98.*

**Motorola's Response to Para. 15:**

Admitted.

16. *Nonetheless, Motorola asserts in its Notice of Opposition that the doctrines of issue preclusion and claim preclusion operate as a bar to registration of Nextel's Chirp. Opp. ¶¶ 27-30.*

**Motorola's Response to Para. 16:**

Motorola admits that it asserts claim preclusion and issue preclusion as grounds for opposing Nextel's Chirp Tone service mark application.

17. *Regarding issue preclusion, Motorola asserts that that the issues that are identical between the prior proceeding and this one are "whether the Chirp Tone is distinctive and functions as a mark," which Motorola also refers to as the "issues of distinctiveness and trademark use." See id. at, ¶¶ 28(a), (c). Motorola further asserts that the Board necessarily determined in the prior proceeding "that the Chirp Tone was non-distinctive and did not function as a mark," and that Applicant is therefore precluded from proving that the mark "is distinctive and registrable on the Principal Register" here. See id. at ¶¶ 28( c), (d).*

**Motorola's Response to Para. 17:**

Motorola admits that the quoted passages appear in its Notice of Opposition.

18. *Regarding claim preclusion, Motorola asserts that "the second claim" (apparently Nextel's registration application here) is based on the same set of transactional facts as "the first" (apparently its opposition in the Nextel v. Motorola case), stating that*

*"The identical Chirp Tone is at issue in both proceedings. The proceedings involve the same issues and the same set of transactional facts, namely, whether the Chirp Tone that is emitted by Motorola's iDEN® handsets during the course of Nextel's applied-for communications services is distinctive and functions as a mark that is registrable on the Principal Register. Due to the relatedness between the iDEN® handsets and the iDEN®-based communications services, there is no distinguishable difference between Motorola's use of the Chirp Tone in connection with the goods at issue in the prior proceeding and Nextel's use of the Chirp Tone in connection with the applied-for services." See Opp. at ¶ 29(c).*

**Motorola's Response to Para. 18:**

Motorola admits that the quoted passages appear in its Notice of Opposition.

19. *Nextel's Application encompasses services as to which the sound is emitted in the normal course of providing them (such as "push to talk" walkie-talkie communications services that operate on the iDEN network) as well as services as to which the Nextel Chirp is not emitted at all (such as position tracking data transmission services). See id. at ¶ 7.*

**Motorola's Response to Para. 19:**

Admitted.

20. *Opposer asserts that as of the February 25, 2005 filing date of Nextel's application:*

*Nextel had not made service mark use of the Chirp Tone in connection with any services other than, at most, two-way radio services offered via Motorola's, or its licensee's, iDEN handsets and iDEN infrastructure. Thus, the only services Nextel could conceivably claim in the Chirp Tone service mark application as of the filing date were those describing two-way radio services, namely: "electronic and digital transmission of voice via wireless networks; two-way radio services; electronic transmission of voice by means of two-way radios, mobile radios; wireless communications services." See id. at ¶ 31.*

**Motorola's Response to Para. 20:**

Motorola admits that the quoted passages appear in its Notice of Opposition.

21. *Opposer asserts that, as a result, "the application is void ab initio as to the remaining services identified in the Chirp Tone service mark application." See id. at ¶ 32.*

**Motorola's Response to Para. 21:**

Motorola admits that the quoted passages appear in its Notice of Opposition.

22. *Contrary to Motorola's assertion in its opposition, Nextel's Application was based upon use in commerce as of the February 25, 2005 filing date of the application. See Application Serial No. 78/575,442.*

**Motorola's Response to Para. 22:**

Motorola admits that Nextel filed its Chirp Tone application on February 25, 2005.

### **III. THE NEXTEL v. MOTOROLA DECISION IS PRECLUSIVE**

Motorola's claim and issue preclusion grounds for opposition are based on the Board's precedential holding in *Nextel v. Motorola*, published as *Nextel Communications, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393 (T.T.A.B. 2009) (precedential). There were three preclusive holdings in that decision: (1) the Chirp Tone failed to function as a mark in connection with "two-way radios"; (2) the Chirp Tone is not inherently distinctive; and (3) the Chirp Tone has

not acquired distinctiveness. Those holdings, in combination with Nextel's admissions that the Chirp Tone is an operational alert tone in connection with several of Nextel's applied-for services, preclude Nextel's application.

**A. The Chirp Tone Fails to Function as a Mark in Connection With Goods or Services That Utilize the Chirp Tone as an Operational Alert Tone**

In *Nextel v. Motorola*, the Board held that the Chirp Tone failed to function as a trademark in connection with "two-way radios." The Board based its holding on issue preclusion grounds,<sup>2</sup> finding that the issue of whether the Chirp Tone functioned as a mark was actually decided in a prior proceeding between Nextel and Motorola. *Id.* at 1399.

That prior proceeding was an opposition filed by Nextel against Motorola's application to register a similar "chirp" sound mark broadcast at a lower 911 Hz pitch (Ser. No. 78/235,618) (hereafter, the "911 Hz Chirp"). In that first opposition (Opp. No. 91/161,817), the Board held that Motorola's 911 Hz Chirp failed to function as a mark in connection with two-way radios. *Id.* at 1399 (citing and summarizing the 911 Hz Chirp decision). The Board arrived at its holding in the 911 Hz Chirp opposition based on evidence establishing that the 911 Hz Chirp served "as an operational alert signal denoting the availability of a communications channel." *Id.* at 1398 (quoting Nextel's brief and the 911 Hz Chirp decision). Consequently, in *Nextel v. Motorola*, the Board held that Motorola's application to register the 1800 Hz Chirp Tone in connection with two-way radios was barred under the doctrine of issue preclusion. *Id.* at 1399 ("Thus, the Board's 911 Hz decision finding that [Motorola's] 911 Hz chirp failed to function as a mark on [Motorola's] two-way radios does have a preclusive effect inasmuch as the application before us now includes two-way radios.").

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<sup>2</sup> Although Nextel did not plead it in its *Nextel v. Motorola* Amended Notice of Opposition, the Board deemed the pleadings to be amended to include issue preclusion as a ground for opposition. *Nextel*, 91 U.S.P.Q.2d at 1399.

Taken together, these decisions hold that the “chirp” tones—the 911 Hz Chirp and the present (1800 Hz) Chirp Tone—fail to function as a mark in connection with two-way radios because the “chirp” is “an operational alert signal denoting the availability of a communication channel.” *Nextel*, 91 U.S.P.Q.2d at 1398. These decisions are preclusive against Nextel’s application to register the identical Chirp Tone in connection with its inextricably related communications services.

As noted in Motorola’s co-pending summary judgment motion, Nextel chose to oppose Motorola’s Chirp Tone application (and the prior 911 Hz Chirp) on invalidity grounds. It must now live with the consequences of that decision. At Nextel’s urging, the Board held that the Chirp Tone—which Nextel now seeks to register as a service mark—did not function as a mark in connection with two-way radios because it was merely an operational alert tone. *Nextel*, 91 U.S.P.Q.2d at 1398-1399 (applying issue preclusion based on prior 911 Hz Chirp decision). As described below, that holding also dooms Nextel’s Chirp Tone application.

Nextel’s summary judgment motion includes the following admissions in its “Statement of Undisputed Facts”:

***In connection with the operation of the Direct Connect<sup>3</sup> service, the subscribers’ wireless devices emit a variety of operational alert tones to signal the user of various status conditions and events. One such tone, which [Nextel] refers to as the “Nextel Chirp,” and which is emitted to signal the “talk permit” status of certain two-way radio communications, is the subject of this proceeding.... (Dkt. #11, Nextel Summary Judgment Mot. at 3, ¶ 2.)***

***[Nextel] seeks registration of the Nextel Chirp based on its use of that sound as a source-identifying brand for a range of services it offers, including not only services for which the sound is an operational alert tone but also services in which the Nextel Chirp***

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<sup>3</sup> Nextel defined “Direct Connect” as a “two-way radio service provided to its subscriber customers over its network, in part using equipment manufactured by [Motorola] ... and by other manufacturers.” (Dkt. #11, Nextel Summary Judgment Mot. at 3, ¶ 1.)

*is not heard at all (i.e., what [Motorola] calls “non-IDEN” services ...), and as a brand identifier for Nextel services in general....* (Dkt. #11, Nextel Summary Judgment Mot. at 3, ¶ 3.)

*During the application process, Nextel stated in a response to an Office Action that “the following services listed in the application involve emission of the sound mark identified in the instant application in the provision of such services: ... Two-way radio services ....”* (Dkt. #11, Nextel Summary Judgment Mot. at 3-4, ¶ 5.)

*Nextel’s Application encompasses services as to which the sound is emitted in the normal course of providing them (such as “push to talk” walkie-talkie communications services that operate on the iDEN network) as well as services as to which the Nextel Chirp is not emitted at all (such as position tracking data transmission services)....* (Dkt. #11, Nextel Summary Judgment Mot. at 8, ¶ 19.)

As Nextel concedes in the above-quoted paragraphs, the Chirp Tone is not only an “operational alert tone” in connection with Motorola’s applied-for goods, *it is an “operational alert tone” in connection with at least some of Nextel’s applied-for services.* (Dkt. #11, Nextel Summary Judgment Mot. at 3-4, 8, ¶¶ 2-3, 5, 19.) As a result, Nextel’s Chirp Tone application is precluded by the Board’s prior “chirp” sound mark holdings because it includes “two-way radio services” and other services that use the Chirp Tone as an operational alert tone. Nextel’s express admission that the Chirp Tone functions as an operational alert tone in connection with its applied-for two-way radio services (and others) confirms that those services are similarly precluded by the Board’s prior “chirp” sound mark decisions. There is no justification for treating them differently—particularly considering that Motorola’s goods and Nextel’s services are interdependent, operating together to permit the consumer to have a two-way radio conversation. *Nextel*, 91 U.S.P.Q.2d at 1397 (“One of its services, which [Nextel] calls ‘Direct Connect,’ allows subscribers to connect directly with each other using [Motorola’s] IDEN-equipped cellular telephone handsets.”).

As a result of Nextel's admissions, Motorola is entitled to summary judgment on preclusion grounds as to the Class 38 services that utilize the Chirp Tone as an operational alert tone. Nextel identified those services, which "involve emission of the sound mark identified in the instant application [Chirp Tone] in the provision of such services," in Para. 5 of its Statement of Undisputed Facts (Dkt. #11 at 3-4, ¶ 5):

Electronic, electric and digital transmission of voice, data, pictures, music, video, and other electronic information via wireless networks; Two-way radio services; Electronic transmission of voice, text, images, data, music and information by means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; Mobile telephone communication services; Wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, information, text, numeric messaging and text messaging and for accessing a global communications network; Telecommunication services, namely, providing user access to telephone and Internet wired or wireless networks for the transmission of voice, data, images, music or video via a combination of persistent interconnection and instant interconnection/instant interrupt technologies; and Wireless communications services.

**B. Nextel's Admission that the Chirp Tone is an Operational Alert Tone is Preclusive Against its Application in its Entirety**

Nextel's admission that the Chirp Tone is an operational alert tone for these Class 38 communication services should bar its Chirp Tone application in its entirety. It is well-settled that a finding of unregistrability as to one item in a class necessitates refusal as to the entire class. *See Electro-Coatings, Inc. v. Precision National Corporation*, 204 U.S.P.Q. 410, 420 (T.T.A.B. 1979). The Board has noted that a class must stand or fall together:

The rationale for the proposition that an application stands or falls and that the Board should not make distinctions between specific goods or services identified in one application (or one class of a multiple class application) seems to be that, on appeal or in an inter partes proceeding, we are adjudicating the registrability of the



mark for the goods or services presented by the applicant. It is not for the Board to enter what is in effect an ex parte amendment to the application in order to salvage what may appear to be redeemable while discarding the other goods or services. The applicant must state what is desired, and on that application, either all will be granted or nothing. *The same rationale applies to an appeal or to an opposition (or cancellation) predicated on any of the statutory grounds available to a plaintiff.*

*Id.* at 420-21 (emphasis added).

Indeed, the Board has applied this principle in a variety of opposition and cancellation proceedings. For example, the Board held that a finding of descriptiveness as to one item in a goods or services description was sufficient to properly refuse the entire class of goods or services. *In re Analog Devices, Inc.* 6 U.S.P.Q.2d 1808, 1810 (T.T.A.B. 1988). It is a “well settled legal principle, without the need to cite precedent...that registration should be refused if the mark is descriptive of any of the goods or services for which registration is sought.” *Electro-Coatings, Inc.*, 204 U.S.P.Q. at 420 (citing *In re American Society of Clinical Pathologists, Inc.*, 169 U.S.P.Q. 800 (C.C.P.A. 1971)).

In the analogous likelihood of confusion context, the Board has held that it is “sufficient if likelihood of confusion is found with respect to use of the mark on any item within the description of goods in the application or registration.” *Hewlett-Packard Development Co. v. Vudu, Inc.*, 92 U.S.P.Q.2d 1630, 1634 n.4 (T.T.A.B. 2009). Once likelihood of confusion is found as to one item in a class, an opposition as to the entire class should be sustained. *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 U.S.P.Q.2d 1251, 1256 n.5 (T.T.A.B. 2009).

Accordingly, Nextel’s admission that the Chirp Tone is an operational alert tone as to two-way radio services—and other applied-for services—should trigger preclusion against the Class as a whole. Although the Board declined to apply preclusion against the class as a whole

in the prior *Nextel v. Motorola* decision, that decision stands as an exception to the well-settled rule that a Class should be considered in its entirety. In fact, the Board acknowledged that it was departing from the general rule in *Nextel v. Motorola*. “Normally, when an opposition is sustained with respect to certain goods or services for which registration is sought, it is generally proper to sustain the opposition with respect to the entire class of goods or services.” *Nextel*, 91 U.S.P.Q.2d at 1399 n.13. It appears that the Board’s reluctance to apply the general rule was based in large part on the fact that claim and issue preclusion were not pleaded as grounds for opposition, and that the preclusive decision (911 Hz Chirp decision) was “relatively recent.” *Nextel*, 91 U.S.P.Q.2d at 1398 (“Neither issue nor claim preclusion was pleaded by [Nextel] as a ground in this proceeding, nor is there a pending motion to amend the pleadings in light of the Board’s relatively recent decision in the 911 Hz case.”); *see also id.* at 1399 n.13 (“Moreover, because issue preclusion was not brought up until the briefing, and the parties clearly view the telephones as presenting a separate and distinct issue, we will not allow the late assertion of issue preclusion to cause the whole class to fail.”) In contrast, Motorola has expressly pleaded claim and issue preclusion in its Notice of Opposition, and the preclusive *Nextel v. Motorola* decision is nearly three years old. There is no issue as to unfair surprise in the present case. Motorola respectfully submits that the prior *Nextel v. Motorola* decision precludes Nextel’s entire Class 38 application—not merely the “operational alert tone” services.

**C. The Chirp Tone is not Inherently Distinctive (*In re Vertex*)**

If the Board declines to apply “operational alert tone” preclusion against Nextel’s Class 38 Chirp Tone application in its entirety, Nextel must prove that the Chirp Tone is either inherently distinctive or has acquired distinctiveness in connection with the remaining services.

However, the Board's *Nextel v. Motorola* holding with respect to "cellular telephones" is preclusive as to either form of distinctiveness.<sup>4</sup>

The Board has already held that the Chirp Tone is not inherently distinctive in connection with communications goods. *Nextel*, 91 U.S.P.Q.2d at 1408. It held that the Chirp Tone was not inherently distinctive because "cellular telephones, including those made by [Motorola] that emit the chirp, fall into the category of goods that make sound in their normal course of operation." *Nextel*, 91 U.S.P.Q.2d at 1400. As a result, "[Motorola's] chirp, used in connection with cellular telephones, falls into the category of sounds that cannot be inherently distinctive and may only be registered upon a showing of acquired distinctiveness." *Id.* at 1400-01 (citing *In re Vertex Group LLC*, 89 U.S.P.Q.2d 1694, 1700 (T.T.A.B. 2009)). That same rationale is applicable to Nextel's applied-for communications services.

In the present case, Nextel has admitted that the Chirp Tone is emitted in the normal course of its services. (Dkt. #10, Nextel Answer ¶¶ 4<sup>5</sup>, 17.<sup>6</sup>) Given the inseparable relationship between Motorola's iDEN® Goods and Nextel's "Direct Connect" iDEN® services, the *In re Vertex* rule as applied to inherent distinctiveness for Motorola's cellular telephones must also apply to Nextel's services. Notably, the Examining Attorney assigned to Nextel's Chirp Tone application held that it did. (See Office Action dated October 29, 2009 ("[t]he applicant [Nextel] is cautioned that, for the services that involve sound, the applicant [Nextel] will need to demonstrate acquired distinctiveness. In other words, where the sound is emitted in the ordinary

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<sup>4</sup> The Board declined to apply issue preclusion against the "cellular telephones" identified in Motorola's Chirp Tone trademark application. *Nextel*, 91 U.S.P.Q.2d at 1399. See discussion at Section III. B. above.

<sup>5</sup> "[Nextel] admits that iDEN handsets provided by Nextel to its customers for use in connection with its services emit the Chirp Tone when the user presses the push-to-talk button and the network locates an open and available channel for communication." (Dkt. #10, Nextel Answer ¶ 4.)

<sup>6</sup> "... [Nextel] admits that among other uses, the Chirp Tone can be used in connection with communications services that utilize the Chirp Tone as an operational alert tone." (Dkt. #10, Nextel Answer ¶ 17.)

course of the services, the applicant [Nextel] will have to demonstrate that consumers recognize the sound as a trademark”).) The Board’s *Nextel v. Motorola* holding that the Chirp Tone was not inherently distinctive based on the *In re Vertex* rule precludes Nextel’s inherent distinctiveness claim.

Nextel argues that the *In re Vertex* decision is inapplicable because it involved goods, not services. However, the *In re Vertex* rationale is applicable to the present application, which involves communications services inextricably tied to the previously-adjudicated “chirping” goods. See *Nextel*, 91 U.S.P.Q.2d at 1397 (finding that Nextel’s “Direct Connect” two-way radio service “allows subscribers to connect directly with each other using [Motorola’s] IDEN-equipped cellular telephone handsets.”). The *In re Vertex* panel noted that, like color and product design trade dress, “certain types” of sound marks require a showing of acquired distinctiveness. *In re Vertex*, 89 U.S.P.Q.2d at 1700. Those include sound marks used in connection with products that emit the sound “in their normal course of operation.” *Id.* It is undisputed that the Chirp Tone is emitted as an operational alert tone in the normal course of at least some of Nextel’s applied-for services. (Dkt. #11, Nextel Summary Judgment Mot. at 3-4, 8, ¶¶ 2-3, 5, 19.) Thus, Nextel’s Class 38 communications services are without doubt the type of services that emit the sound “in the normal course of operation.” *In re Vertex*, 89 U.S.P.Q.2d at 1700. As a result, Nextel’s attempt to distinguish *In re Vertex* is unavailing. The Chirp Tone cannot be deemed inherently distinctive for Nextel’s applied-for communications services. The Board’s *Nextel v. Motorola* holding that the Chirp Tone is not inherently distinctive based on *In re Vertex* is preclusive. Consequently, to the extent its Chirp Tone application survives the operational alert tone preclusion described in Section III. A. above (*i.e.*, for any applied-for

service not utilizing the Chirp Tone as an operational alert tone), Nextel must establish acquired distinctiveness.

**D. The Chirp Tone has not Acquired Distinctiveness (Concurrent Uses)**

In *Nextel v. Motorola*, the Board held that the “most damaging” evidence with respect to acquired distinctiveness was then-applicant Motorola’s non-exclusive use of the Chirp Tone:

What is perhaps the most damaging to applicant’s [Motorola’s] case for acquired distinctiveness is that the record establishes that opposer [Nextel] has been extensively using the chirp in advertisements in connection with its services for a number of years. And, “[i]n most oppositions to registrations under Section 2(f), prevailing opposers have presented some evidence that the mark has not acquired distinctiveness, such as others’ use of the proposed mark or similar marks.’ [Citations omitted.] Here, opposer [Nextel] has demonstrated that it has used the chirp in connection with its services for promotional purposes nearly as long as applicant [Motorola].

*Nextel*, 91 U.S.P.Q.2d at 1408.

Just as Nextel’s concurrent use of the Chirp Tone in connection with its communications services rendered Motorola’s use of the Chirp Tone non-substantially-exclusive in *Nextel v. Motorola*, Motorola’s use of the Chirp Tone in connection with its related goods renders Nextel’s use non-substantially-exclusive in the present case. There is no dispute that both Motorola and Nextel concurrently use the Chirp Tone. *Nextel*, 91 U.S.P.Q.2d at 1408. Although Nextel may argue that Motorola’s Chirp Tone use is irrelevant because it was not deemed registrable trademark use, such an argument would be contrary to well-established case law. Even “non-trademark” use defeats a claim of substantially exclusive use. *See* 15 U.S.C. § 1052(f); *Flowers Indus., Inc. v. Interstate Brands Corp.*, 5 U.S.P.Q.2d 1580, 1589 (T.T.A.B. 1987) (holding “descriptive” uses relevant to Section 2(f) analysis). Moreover, Nextel admitted that its competitor Southern Communications uses the Chirp Tone in connection with its competing services in a limited geographic area. (Dkt. #10, Nextel Answer ¶ 5.)

Surprisingly, Nextel's summary judgment motion makes no mention of this "most damaging" concurrent use evidence. The Board's holding that the parties' concurrent use of the Chirp Tone was the most damaging evidence against Motorola's acquired distinctiveness claim is equally applicable to Nextel's acquired distinctiveness claim. The Board held that Motorola's use of the Chirp Tone was not substantially exclusive in light of Nextel's concurrent use. *Nextel*, 91 U.S.P.Q.2d at 1408. By that same rationale, Nextel's use of the Chirp Tone is not substantially exclusive in light of Motorola's use. As a result, the prior *Nextel v. Motorola* holding precludes Nextel's acquired distinctiveness claim.

#### **IV. THE PRIOR *NEXTEL v. MOTOROLA* DECISION IS PRECLUSIVE AGAINST NEXTEL'S CHIRP TONE APPLICATION**

Motorola's co-pending cross-motion for summary on preclusion grounds applied the various claim preclusion and issue preclusion factors to the present case. (Dkt. #12.) For the reasons set forth in that motion, Motorola respectfully submits that under either doctrine, Motorola is entitled to summary judgment on preclusion grounds. Nextel does not dispute that there are no genuine issues of material fact precluding summary judgment. Nextel only disputes whether the doctrines bar its subsequent Chirp Tone application. Nextel's position is that the doctrines are not applicable to its Chirp Tone application, and that as a result, it is entitled to summary judgment. Both parties agree that claim and issue preclusion are ripe for adjudication on summary judgment.

In direct contrast to its prior position in *Nextel v. Motorola*, upheld by the Board, Nextel seeks to re-litigate these claims and issues to establish that: (1) the Chirp Tone functions as a mark; (2) is inherently distinctive; (3) has acquired distinctiveness, and is ultimately registrable on the Principal Register. However, Nextel is bound by the prior *Nextel v. Motorola* decision it

obtained in 2009 and is now precluded from relitigating those same claims and issues in this proceeding.

“Summary judgment is an appropriate method of disposing of a case in which there is no genuine dispute as to any material fact, thus leaving the case to be resolved as a matter of law.”

*Mattel, Inc. v. The Brainy Baby Co., LLC*, 101 U.S.P.Q.2d 1140, 1142 (T.T.A.B. 2011)

(precedential). Summary judgment is appropriate in preclusion cases. *See, e.g., Zoba Int’l Corp.*

*v. DVD Format/LOGO Licensing Corp.*, 98 U.S.P.Q.2d 1106, 1108-09 (T.T.A.B. 2011)

(precedential) (claim preclusion); *DaimlerChrysler Corp. v. Maydak*, 86 U.S.P.Q.2d 1945, 1949-

50 (T.T.A.B. 2008) (precedential) (issue preclusion). For the reasons set forth in its cross-

motion, Motorola respectfully submits that it is entitled to summary judgment on claim and issue preclusion grounds.

## **V. CONCLUSION**

Motorola respectfully requests the Board to: (1) deny Nextel’s motion for summary judgment on claim and issue preclusion; and (2) grant Motorola’s cross-motion. The Board has already held that the Chirp Tone does not function as a mark where it is used as an operational alert tone. It has further held that the Chirp Tone cannot be deemed inherently distinctive where it is emitted in the normal course of operation. Moreover, it has held that the Chirp Tone has not acquired distinctiveness due to concurrent use. Consequently, Motorola is entitled to judgment in its favor on all Class 38 services identified in Nextel’s Chirp Tone service mark application

based on the Board's precedential ruling in *Nextel v. Motorola* involving the same parties and the identical Chirp Tone mark.

Dated: March 12, 2012

Respectfully submitted,  
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**CERTIFICATE OF SERVICE**

On March 12, 2012, I served the foregoing **OPPOSERS' RESPONSE TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT ON PRECLUSION** on the parties in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at Chicago, Illinois, enclosed in a sealed envelope addressed to counsel of record for Applicant as follows:

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By: /s/Thomas M. Williams  
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